

ESTTA Tracking number: **ESTTA639479**

Filing date: **11/17/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Yeti Cycling, LLC
Granted to Date of previous extension	11/16/2014
Address	621 Corporate Circle, Unit B Golden, CO 80401 UNITED STATES
Attorney information	Stephen A. Zemanick Dorsey & Whitney LLP 1400 Wewatta Street, Suite 400 Denver, CO 80202 UNITED STATES docketing-dv@dorsey.com, zemanick.steve@dorsey.com, murray.kristi@dorsey.com, johnston.lee@dorsey.com Phone:303-629-3400

Applicant Information

Application No	86161534	Publication date	05/20/2014
Opposition Filing Date	11/17/2014	Opposition Period Ends	11/16/2014
Applicant	YETI COOLERS, LLC 5301 Southwest Parkway Austin, TX 78735 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Cup holders for use in vehicles;
Carts,namely, wheeled, collapsible carts for transporting and hauling objects

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3323853	Application Date	01/24/2005
Registration Date	10/30/2007	Foreign Priority	NONE

		Date	
Word Mark	YETI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use: First Use: 1985/08/31 First Use In Commerce: 1987/04/30 Bicycles; bicycle components and accessories, namely, bicycle frames, [bicycle handlebars,] bicycle handlebar grips [, and water bottle holders] for affixation to bicycles</p> <p>Class 025. First use: First Use: 1986/01/01 First Use In Commerce: 1987/04/30 Clothing, namely, t-shirts, jerseys, shorts, [pants,] hats, caps, sweatshirts, socks, jackets</p>		

U.S. Registration No.	4097890	Application Date	10/28/2010
Registration Date	02/14/2012	Foreign Priority Date	NONE
Word Mark	YETI		
Design Mark			
Description of Mark	The mark consists of the word "YETI" instylized lettering.		
Goods/Services	<p>Class 012. First use: First Use: 2009/04/30 First Use In Commerce: 2009/04/30 Bicycles; bicycle components and accessories, namely, bicycle frames, bicycle handlebars, bicycle handlebar grips, and water bottle holders for affixation to bicycles</p> <p>Class 025. First use: First Use: 2009/04/30 First Use In Commerce: 2009/04/30 clothing, namely, shirts, jerseys, shorts, pants, hats, caps, sweatshirts, socks, jackets</p>		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	YETI		
Goods/Services	Water bottles, drinking mugs and tumblers, pint glasses, insulated containers for beverages, bottle openers and additional bicycle parts and accessories		

Related Proceed-	Opposer is simultaneously filing a notice of opposition against applicant's Class
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ings	17 application number 86/161,569
Attachments	78553013#TMSN.png(bytes) 85163649#TMSN.png(bytes) Notice of Opposition - 86-161534.pdf(232177 bytes) Exhibit A to Notice of Opposition.pdf(38251 bytes) Exhibit B to Notice of Opposition.pdf(18787 bytes) Exhibit C to Notice of Opposition.pdf(564056 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kristi Murray/
Name	Kristi Murray
Date	11/17/2014

In the matter of U.S. Trademark Application Serial No. 86/161,534
Mark: YETI
Published on May 20, 2014

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Opp. Ref. No. M246819

Yeti Cycling, LLC, a limited liability company organized and existing under the laws of Delaware, having a principal place of business at 621 Corporate Circle, Unit B, Golden, Colorado 80401 ("Opposer"), believes it will be damaged by the registration of the YETI trademark reflected in U.S. Application No. 86/161,534, filed by Yeti Coolers, LLC ("Applicant") on January 9, 2014, and having been granted an extension of time to oppose until November 16, 2014, hereby opposes the same.

1. Applicant filed U.S. Service Mark Application No. 86/161,534, the subject of this opposition, on January 9, 2014, for the YETI trademark for use with “*cup holders for use in vehicles; carts, namely, wheeled, collapsible carts for transporting and hauling objects*” in International Class 12 (the “Application”).

2. The Application was filed under Section 1(b) of the Trademark Act, based on Applicant's intent to use the YETI trademark in commerce in connection with the goods described in the preceding paragraph.

3. The Application was published for opposition in the Official Gazette (Trademarks) on May 20, 2014.

4. Opposer sought a 90-day extension of time to oppose the Application on June 17, 2014 and was granted such request extending its deadline to oppose until September 17, 2014.

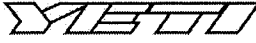
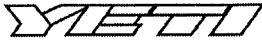
5. Opposer obtained the consent of Applicant to seek a further 60-day extension of time to oppose the Application and sought such extension on September 16, 2014. Opposer was granted the additional 60-day extension of time extending its deadline to oppose until November 16, 2014.

6. Opposer is the owner of common law rights in the YETI trademark for various goods and is also the owner of U.S. Trademark Registration No. 3,323,853 for the YETI trademark covering the following goods:

"Bicycles; bicycle components and accessories, namely, bicycle frames, bicycle handlebar grips for affixation to bicycles," in International Class 12; and

"Clothing, namely, t-shirts, jerseys, shorts, hats, caps, sweatshirts, socks, jackets," in International Class 25.

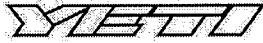
A current printout of information from the electronic database records of the U.S. Patent and Trademark Office's TSDR (Trademark Status and Document Retrieval) database showing the current status and title (owner) of U.S. Registration No. 3,323,853 is attached hereto as Exhibit A.


7. Opposer is the owner of common law rights in the  trademark for various goods and is also the owner of U.S. Trademark Registration No. 4,097,890 for the  mark covering the following goods:

“Bicycles; bicycle components and accessories, namely, bicycle frames, bicycle handlebars, bicycle handlebar grips, and water bottle holders for affixation to bicycles,” in International Class 12; and

“Clothing, namely, t-shirts, jerseys, shorts, pants, hats, caps, sweatshirts, socks, jackets,” in International Class 25.

A current printout of information from the electronic database records of the U.S. Patent and Trademark Office's TSDR (Trademark Status and Document Retrieval) database showing the current status and title (owner) of U.S. Registration No. 4,097,890 is attached hereto as Exhibit B. The goods subject to registration under U.S. Registration Nos. 3,323,853 and 4,097,890 are collectively referred to herein as, “Opposer's Registered Goods.” Opposer's

YETI and  trademarks are collectively referred to herein as the “Opposer's YETI Trademarks.”

8. Opposer's U.S. Registrations for the YETI and  marks are valid and subsisting and in full force and effect. Additionally, Opposer's U.S. Registration for the YETI trademark has become incontestable pursuant to 15 U.S.C. § 1065.

9. Opposer is the owner of common law rights in Opposer's YETI Trademarks for various goods in addition to Opposer's Registered Goods, including but not limited to, water bottles, drinking mugs and tumblers, pint glasses, insulated containers for beverages, bottle openers and additional bicycle parts and accessories. Screen shots of Opposer's website showing representative examples of some of these additional goods for sale are attached hereto as Exhibit C (Opposer's goods that are not subject to registration under U.S. Registration Nos. 3,323,853 or 4,097,890 are collectively referred to herein as “Opposer's Unregistered

Goods,” and Opposer’s Registered Goods and Opposer’s Unregistered Goods are collectively referred to herein as “Opposer’s Goods”).

10. Opposer and/or its predecessors adopted the YETI trademark and have used it continually in U.S. commerce in connection with Opposer’s Goods since at least as early as April 30, 1987, over 25 years prior to the January 9, 2014 filing date of the Application.

11. Opposer and its predecessors have expended substantial amounts of money, time and effort in advertising, promoting and popularizing Opposer’s YETI Trademarks, so that the cycling, outdoor and recreational products trade in general, and the relevant purchasing consumers in particular, have come to know and recognize Opposer’s Goods branded under Opposer’s YETI Trademarks and to know that the same originate with Opposer. Opposer derives substantial goodwill and value from the aforesaid recognition, association and identification by the relevant consumers, industry and trade.

12. The Application seeks registration of the YETI trademark, which is identical to Opposer’s YETI trademark, and the goods identified in the Application are so related to Opposer’s Goods as to be likely to confuse, to deceive, or to cause consumers to mistake Applicant’s goods for goods authorized, sponsored by or otherwise associated with Opposer.

13. The goods with which Applicant intends to use with the YETI trademark fall within the natural zone of expansion of Opposer’s Goods for which Opposer already has obtained senior rights.

14. The goods with which Applicant intends to use with the YETI trademark and Opposer’s Goods are highly-related, appeal to the same class of purchasers, and are likely to be advertised and sold in the same markets through the same channels of trade.

15. Opposer and/or its predecessors have built up exclusive goodwill and reputation in connection with Opposer’s YETI Trademarks. Opposer’s goodwill and reputation will be

damaged and jeopardized by Applicant's use and registration of the YETI trademark for the goods covered by the Application.

16. The registration and use by Applicant of the YETI trademark subject to the Application will dilute or impair Opposer's trademark rights and will eventually result in a lack of designation, indication of origin, loss of distinctiveness and/or the exclusivity of Opposer's YETI Trademarks.

17. Opposer has superior and paramount rights as compared to Applicant, and Opposer and/or its predecessors have used Opposer's YETI Trademarks in commerce continuously and for a time long prior to any date claimed by Applicant, and, consequently, Opposer avers that confusion, mistake and deception in the trade and in the minds of purchasers as to the source, origin, affiliation, sponsorship or connection of the respective products will be likely and bound to occur, with resulting damage to Opposer. Accordingly, the Application is not entitled to registration under 15 U.S.C. § 1052(d).

18. Opposer will be damaged by the registration sought by Applicant within the meaning of 15 U.S.C. § 1063, because such registration would support and assist Applicant in the confusing, misleading and dilutive use of Applicant's YETI trademark, and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that the registration sought by Applicant be denied.

Serial No.: 86/161,534
Mark: YETI
Page: 6

ATTORNEYS FOR OPPOSER

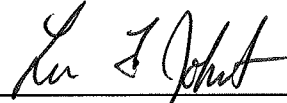
Please recognize as attorneys for Opposer in this proceeding Lisa A. Osman, Lee Johnston and Steve Zemanick, members of the Bar of the State of Colorado, whose address is Dorsey & Whitney, LLP, 1400 Wewatta Street, Suite 400, Denver, Colorado 80202-5549.

Please address all communications regarding this opposition proceeding to Lisa A. Osman.

Dated: November 16, 2014

Respectfully submitted,

DORSEY & WHITNEY LLP

By: 

Lisa A. Osman
Lee Johnston
Steve Zemanick
1400 Wewatta Street, Suite 400
Denver, Colorado 80202-5549
Tel: (303) 629-3400
Fax: (303) 629-3450
osman.lisa@dorsey.com
johnston.lee@dorsey.com
zemanick.stephen@dorsey.com

ATTORNEYS FOR OPPOSER
YETI CYCLING, LLC

Serial No.: 86/161,534

Mark: YETI

Page: 7

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **Notice of Opposition** has been served on Yeti Coolers, LLC by mailing said copy on November 17, 2014, via First Class Mail, postage prepaid, to:

Joseph J. Berghammer, Esq.
Banner & Witcoff, Ltd.
10 S. Wacker Drive; Suite 3000
Chicago, Illinois 60606-7437


Rosa M. Baxendale

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Mark: YETI

YETI

US Serial Number: 78553013

Application Filing Date: Jan. 24, 2005

US Registration Number: 3323853

Registration Date: Oct. 30, 2007

Register: Principal

Mark Type: Trademark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Nov. 12, 2013

Publication Date: Aug. 14, 2007

Mark Information

Mark Literal Elements: YETI

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Bicycles; bicycle components and accessories, namely, bicycle frames, [bicycle handlebars,] bicycle handlebar grips [, and water bottle holders] for affixation to bicycles

International Class(es): 012 - Primary Class

U.S Class(es): 019, 021, 023, 031, 035, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 31, 1985

Use in Commerce: Apr. 30, 1987

For: Clothing, namely, t-shirts, jerseys, shorts, [pants,] hats, caps, sweatshirts, socks, jackets

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1986

Use in Commerce: Apr. 30, 1987

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Yeti Cycling, LLC

Owner Address: 600 Corporate Circle, Unit D
Golden, COLORADO 80401
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where
Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Stephen A. Zemanick

Docket Number: T223595.US.0

Attorney Primary Email Address: docketing-dv@dorsey.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Stephen A. Zemanick
Dorsey & Whitney LLP
1400 Wewatta Street, Suite 400
IP Department
Denver, COLORADO 80202-5549
UNITED STATES

Phone: (303) 629-3400

Fax: (303) 629-3450

Correspondent e-mail: docketing-dv@dorsey.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 12, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Nov. 12, 2013	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76985
Oct. 24, 2013	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	76985
Nov. 12, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76985
Oct. 24, 2013	TEAS SECTION 8 & 15 RECEIVED	
Oct. 04, 2011	ATTORNEY REVOKED AND/OR APPOINTED	
Oct. 04, 2011	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Oct. 30, 2007	REGISTERED-PRINCIPAL REGISTER	
Aug. 14, 2007	PUBLISHED FOR OPPOSITION	
Jul. 25, 2007	NOTICE OF PUBLICATION	
May 21, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	78289
May 21, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 17, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	78289
May 14, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	78289
May 14, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 29, 2006	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	78289
Nov. 28, 2006	ASSIGNED TO LIE	78289
May 22, 2006	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	
Nov. 14, 2005	LETTER OF SUSPENSION E-MAILED	6332
Nov. 14, 2005	SUSPENSION LETTER WRITTEN	76511
Nov. 14, 2005	TEAS/EMAIL CORRESPONDENCE ENTERED	88888
Nov. 08, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	88888
Nov. 08, 2005	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 19, 2005	CORRESPONDENCE E-MAILED	
Oct. 19, 2005	SUSPENSION LETTER WRITTEN	76511
Oct. 18, 2005	TEAS/EMAIL CORRESPONDENCE ENTERED	72589
Oct. 12, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	72589
Oct. 12, 2005	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Aug. 22, 2005	NON-FINAL ACTION E-MAILED	6325
Aug. 22, 2005	NON-FINAL ACTION WRITTEN	76511
Aug. 22, 2005	ASSIGNED TO EXAMINER	76511
Feb. 02, 2005	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 110

Date in Location: Nov. 12, 2013

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Mark: YETI



US Serial Number: 85163649
US Registration Number: 4097890
Register: Principal
Mark Type: Trademark
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.
Status Date: Feb. 14, 2012
Publication Date: Nov. 29, 2011

Application Filing Date: Oct. 28, 2010
Registration Date: Feb. 14, 2012

Mark Information

Mark Literal Elements: YETI
Standard Character Claim: No
Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)
Description of Mark: The mark consists of the word "YETI" in stylized lettering.
Color(s) Claimed: Color is not claimed as a feature of the mark.
Design Search Code(s): 26.11.21 - Rectangles that are completely or partially shaded

Related Properties Information

Claimed Ownership of US Registrations: 3323853

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Bicycles; bicycle components and accessories, namely, bicycle frames, bicycle handlebars, bicycle handlebar grips, and water bottle holders for affixation to bicycles

International Class(es): 012 - Primary Class
Class Status: ACTIVE
Basis: 1(a)
First Use: Apr. 30, 2009

U.S Class(es): 019, 021, 023, 031, 035, 044
Use in Commerce: Apr. 30, 2009

For: clothing, namely, shirts, jerseys, shorts, pants, hats, caps, sweatshirts, socks, jackets

International Class(es): 025 - Primary Class
Class Status: ACTIVE
Basis: 1(a)
First Use: Apr. 30, 2009

U.S Class(es): 022, 039
Use in Commerce: Apr. 30, 2009

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Yeti Cycling, LLC
Owner Address: 600 Corporate Circle, Unit D
Golden, COLORADO 80401

UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where
Organized: DELAWARE**Attorney/Correspondence Information****Attorney of Record**

Attorney Name: Stephen A. Zemanick

Docket Number: T224134.US.0

Attorney Primary Email
Address: docketing-dv@dorsey.comAttorney Email
Authorized: No**Correspondent**Correspondent
Name/Address: Stephen A. Zemanick
Dorsey & Whitney LLP
1400 Wewatta Street, Suite 400
IP Department
Denver, COLORADO 80202-5549
UNITED STATES

Phone: (303) 629-3400

Fax: (303) 629-3450

Correspondent e-mail: docketing-dv@dorsey.comCorrespondent e-mail
Authorized: Yes**Domestic Representative - Not Found****Prosecution History**

Date	Description	Proceeding Number
Feb. 14, 2012	REGISTERED-PRINCIPAL REGISTER	
Nov. 29, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 29, 2011	PUBLISHED FOR OPPOSITION	
Nov. 09, 2011	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Oct. 26, 2011	LAW OFFICE PUBLICATION REVIEW COMPLETED	67287
Oct. 24, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 21, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED	67287
Oct. 21, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	67287
Oct. 19, 2011	ASSIGNED TO LIE	67287
Oct. 11, 2011	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 11, 2011	PETITION TO REVIVE-GRANTED	88889
Oct. 11, 2011	TEAS PETITION TO REVIVE RECEIVED	
Oct. 04, 2011	ATTORNEY REVOKED AND/OR APPOINTED	
Oct. 04, 2011	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Sep. 06, 2011	ABANDONMENT NOTICE MAILED - FAILURE TO RESPOND	
Sep. 06, 2011	ABANDONMENT - FAILURE TO RESPOND OR LATE RESPONSE	
Feb. 08, 2011	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Feb. 08, 2011	NON-FINAL ACTION E-MAILED	6325
Feb. 08, 2011	NON-FINAL ACTION WRITTEN	76487
Feb. 08, 2011	ASSIGNED TO EXAMINER	76487
Nov. 03, 2010	NOTICE OF DESIGN SEARCH CODE MAILED	
Nov. 02, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Nov. 01, 2010	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information**TM Staff Information - None****File Location**

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Feb. 14, 2012













